

## REMARKS

Claims 1-3 and 5-21 are currently pending in the application and at issue. As an initial matter, Applicant would like to thank the Examiner for withdrawing the final rejection made on October 13, 2006 and for the clarification regarding claim 1.

Claims 1-3, 5-9, and 11-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,175,963 (Loeffelholz) in view of U.S. Patent No. 6,370,696 (Kronenberger).

Applicant would like to incorporate by reference herein the arguments made in the Amendment submitted on January 16, 2007, and further supplement the arguments by way of the present Response. Furthermore, Applicant responds herein to the Examiner's response to the previous Amendment, as well as the case law cited therein.

The Examiner disagrees with Applicant's argument that the claimed device is analogous to the structure that was addressed in *In re Miller* (418 F.2d 1392) and found by the Court therein to be patentable. The Examiner states that the indicia in *In re Miller* modify how the measuring cup therein is used. Applicant respectfully disagrees. The cup in *In re Miller* is still just that - a cup with a configuration that is functional in the same manner to contain and measure a quantity of flowable material, with or without the indicia. The information/printed matter/indicia found on the cup modifies the functionality of the cup only in the sense that what appear as amounts called for in full recipes are only fractional recipe amounts. **In short, the nature/content of the information conveyed by the printed matter is what supported patentability.**

Similarly, the headwear in the present application still functions as a conventional headwear piece, but changes resulting from the addition of certain information containing indicia/information make the headwear piece function differently. The different and enhanced functionality is attributable to the nature and specific location of the information. Specifically, the recited information, as well as its strategic location, modifies the functionality of the headwear piece from conventional headwear such that it: a) serves as a novel souvenir for an event; and b) is usable in the same form by individual participants in the event in a manner wherein it functionally, prominently identifies the event and more subtly identifies the participants thereon in a unique manner.

More specifically, as recited in claim 1, the event is identifiable from a front perspective by reason of the specific location of the event-identifying indicia on the recited octants at the front region of the headwear piece. Thus, for a baseball event, with the headwear piece in the form of a baseball cap, the event indicia can be readily viewed by observing the players from a front perspective, as is commonly done on televised games. The event thus is prominently identified and thereby promoted.

Elsewhere on the headwear piece, the identification of event participants is placed so as not to dominate the frontal view to detract from the event indicia function. However, the information relating to the participants is viewable by holding the headwear piece in hand and turning it. Thus, spectators are given a unique souvenir as a memorial for the event.

The Examiner suggests that the indicia must somehow structurally modify the cap beyond the application of information thereon. Again, this goes against the holding in *In re Miller*. The information in *In re Miller* did not structurally modify the shape or basic

function of the cup, but instead the nature of the information on the cap structure permitted the structure to have a new function. Therefore, to support patentability, the information need not modify the structure in a manner beyond the application of indicia/information thereto.

The Examiner admits that the information of Loeffholz and Kronenberger is not the same as recited in the present claims. The Examiner states further that the only difference between the recited claims and the structure in the cited references is in the content of the information. The Examiner cites *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004), for the proposition that when the prior art "describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given patentable weight" (Office Action pg. 3).

*In re Ngai* is readily distinguishable from the present fact situation. In *In re Ngai*, the claim was directed to a known kit having instructions for describing a method. The Federal Circuit stated "the printed matter in no way depends on the kit, and the kit does not depend on the printed matter." 367 F.3d at 1339. Thus there was no direct functional interrelationship between the kit and instructions that supported patentability. Conversely, the Applicant's recited information performs its critical function by reason of its content and the strategic way in which it is applied to the headwear piece to thereby modify the function of the headwear piece.

The Court contrasted the device in *Ngai* with the device in *In re Gulack*, which would not achieve its intended result without the recited information. As argued in the previous Amendment, the functional relationship between Applicant's claimed information and the headwear piece is similar to the functional relationship in *In re Gulack*. The present

invention is similar to *In re Gulack* because, just as in *In re Gulack*, the first and second information is functionally related to the headwear piece/band. The headwear piece is analogous to the band in *In re Gulack*, as both structures are used as substrates for information. The first and second information is analogous to the digits because just as the digits are a unique combination of information associated by an algorithm used to educate a user as to the relationship between numbers (a mathematical problem), the first and second information is associated/related to educate a user as to the relationship between an event and the specific participants in the event. Furthermore, in the present case, the information is recited as being at specific locations on the cap. Therefore, the content of the information, as well as the recited location of the information, must be given patentable weight.

In view of the above, the rejection is improper and should be withdrawn as the Examiner has not given appropriate weight and consideration to the recited language in the claims. Specifically, independent claim 1, from which all remaining claims depend, recites "first information identifying an event on at least one of the front/left side and front/right side octants; and second information identifying a plurality of participants in the event on at least one of [eight recited octants]." This structure is simply not disclosed or obvious from the cited references. In fact, the Examiner admits that this recited structure is not shown in the cited art.

It is also interesting to note the attached depiction of a cap (Attachment A), that the Examiner cited in the May 17, 2006 Action and described on pg. 6 to "[show] the claimed invention". Either this cap resulted from copying of Applicant's invention, or it was developed independently by a third party. If the former, this copying supports

unobviousness as relating to important "secondary considerations". If the latter, the development of this unique concept by two entities for the first time after the turn of the century in a highly mature industry, also supports patentability.

Claims 2-3, 5-9, and 11-18 depend cognately from claim 1 and recite further significant structural detail to further distinguish over the combination of Loeffelholz and Kronenberger. Furthermore, patentable weight must be given to the features recited therein as the information, as well as the location of the information, has a functional relationship with the cap, which cannot be ignored.

For example, claim 2 recites that the second information can be seen but is not identifiable when viewing the headwear piece from a front elevation perspective, whereas claim 3 recites that the second information cannot be seen from a front elevational perspective. As discussed in the previous Amendment, the location of the information, as well as the ability to view and identify the information resulting therefrom selectively and strategically from different locations, must be given patentable weight.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Loeffelholz in view of Kronenberger and further in view of U.S. Patent No. 6,408,443 (Park). Park adds nothing regarding the above-noted shortcomings of Loeffelholz and Kronenberger. Therefore, as Loeffelholz, Kronenberger and Park, each taken alone or in combination, fail to disclose or suggest the features recited in independent claim 1, the rejection of dependent claim 10 is improper and should be withdrawn.

Claims 19-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Loeffelholz in view of Kronenberger and further in view of U.S. Patent No. 5,584,076 (Armstrong). Claims 19-21 are directed to an adjustable strap, and in the case of claims

20 and 21, information thereon. Claims 21 specifically characterizes the information as identifying the event, as does the first information recited in claim 1.

While Armstrong discloses information on an adjustable strap, the information is not described as being correlated with any corresponding first and second information, as with an event, as claimed. Additionally, Armstrong adds nothing regarding the above-noted shortcomings of Loeffelholz and Kronenberger. Therefore, as Loeffelholz, Kronenberger and Park, each taken alone or in combination, fails to disclose or suggest the features recited in independent claim 1, the rejection of dependent claims 19-21 is improper and should be withdrawn.

Reconsideration of the rejection of claims 1-3 and 5-21 and allowance of the case are requested.

Respectfully submitted,

By   
John S. Mortimer, Reg. No. 30,407

WOOD, PHILLIPS, KATZ,  
CLARK & MORTIMER  
500 W. Madison St., Suite 3800  
Chicago, IL 60661  
(312) 876-1800

Date: 



## Attachment A